

REMARKS

Claims 35-36, 39, 42, 44-47, 49-53, 55-57, 60-64, 66-77, 79, 81-85, 87, 92-94 and 96-101 remain in this application, with Claims 1-34, 40, 41, 43, 48, 54, 65, 80, 88-91 and 95 cancelled, Claims 37, 38, 58, 59, 78, and 86 withdrawn from consideration, and Claims 35, 39 and 55 amended. By these amendments, no new matter has been added.

The Examiner objected to and rejected Claims 35, 56 and 95 under 35 U.S.C. §§ 132(a) and 112, first paragraph, respectively, for adding new matter into the disclosure and for claiming subject matter that was not sufficiently described in the specification. This objection/rejection is respectfully traversed.

Claim 35 provides the steps of (i) receiving a data request from a patient via a secure publicly accessible network connection and (ii) querying at least one database from a plurality of databases that contain medical records data, appointment scheduling data and billing data pertaining to the patient. These features are disclosed in the specification, for example, in Figure 1 and at pages 2, 4, 6-7, 9-10 and 13. For example, the specification provides that “[p]atient data may be accessed ... through an intranet, **a secure internet**, a LAN, or a WAN. ... One way this is accomplished is by enabling patients to connect to their provider’s web site and view appointments and detailed patient information from a **password-protected screen**.” Pages 2 and 4 (emphasis added); see also Figure 1 and pages 9-10 (“One browser, 11, is connected through an internet service provider, 21, to and through the public internet, 23, to a web server.”).

The specification further provides that the patient data is stored in “**one or more databases**” (page 10 (emphasis added); see also Figure 1, ref. nos. 71, 73 and 75) and may include “**clinical records, treatment records, diagnoses, treatment plans, appointment reminders, recalls, bills, payment overdue reminders, no shows, greetings, prescriptions, referral, and referral reports**” (page 2 (emphasis added)).

Because the aforementioned steps are sufficiently disclosed in the specification, the objection/rejection of Claim 35 should be withdrawn. Furthermore, because the amendment of Claim 56 added limitations that are similar to the aforementioned steps, the objection/rejection of Claim 56 should also be withdrawn. Finally, while the Applicants believe that Claim 95 is sufficiently disclosed in the specification, the Applicants have cancelled Claim 95 in order to expedite examination of the present application, rendering the objection/rejection of Claim 95 moot.

The Examiner further objected to Claims 39 and 55 for depending from withdrawn and/or cancelled claims. The Applicants have amended these claims so that they now depend from pending claims. This objection should therefore be withdrawn.

The Examiner rejected Claims 35, 36, 39, 42, 55-57, 60-64, 71-77, 79, 81-85, 98, 92-93 and 98-101 under 35 U.S.C. § 103(a) as being unpatentable over Evans (U.S. Pat. No. 5,924,074) in view of Halamka ("Virtual Consolidation of Boston's Beth Israel and New England Deaconess Hospitals via the World Wide Web") and Joao (U.S. Pat. No. 6,283,761). The Examiner also rejected Claims 44-47, 49, 66-70 and 94-97 under 35 U.S.C. § 103(a) as being unpatentable over Evans in view of Halamka, Joao and Bessette (U.S. Pat. No. 6,263,330). The Examiner further rejected Claim 50 under 35 U.S.C. § 103(a) as being unpatentable over Evans in view of Halamka, Joao and Ralston (U.S. Pat. No. 6,389,454). The Examiner further rejected Claim 51 under 35 U.S.C. § 103(a) as being unpatentable over Evans in view of Halamka, Joao and Cummings, Jr. (U.S. Pat. No. 5,301,105). The Examiner further rejected Claims 52 and 53 under 35 U.S.C. § 103(a) as being unpatentable over Evans in view of Halamka, Joao, Cummings and Sackler (U.S. Pat. No. 5,235,507). All of the foregoing rejections are respectfully traversed.

The Examiner correctly stated that Evans fails to disclose several limitations that are included in independent Claims 35, 56 and 92, including, for example, (i) querying at least one database from a plurality of databases via a database connectivity module, the plurality of databases containing medical records data, appointment data, and billing

data pertaining to the patient, (ii) receiving a data request from a patient, (iii) determining the access status of the patient, (iv) records are accessible to the patient, and (v) presenting data to the patient. See Office Action, pages 6, 10 and 16. The Examiner then stated that these limitations, however, are disclosed in Joao. While the Applicants respectfully disagree that these limitations are disclosed in Joao, ***Joao is not effective as a prior art reference.***

Joao was filed on December 31, 1999, which was at least ***two months after*** the Applicants conceived of and reduced to practice the present invention. Such conception/reduction to practice was discussed at length in Applicants' Responses dated December 30, 2003 and September 20, 2004. For example, in the Declaration of Frith Maier in Response to Requirement for Information, which was filed on September 20, 2004, Ms. Maier stated that the present invention, as embodied in the Ortho Sesame product, was beta tested in October 1999. See, e.g., Paragraphs 1-14 and Exhibit A (Beta Test Agreement between Patient Interactive and Dr. Craig Williams, dated October 14, 1999). Therefore, Joao, which was filed several months later, cannot be considered prior art as to the present invention.

While Joao states, on its face, that it is a continuation-in-part of U.S. Patent Application No. 09/162,889, filed on September 29, 1998, which is a continuation-in-part of U.S. Patent Application No. 08/600,771, filed on February 13, 1996, now U.S. Patent No. 5,961,332, it is not entitled to an earlier filing date. This is because the prior applications do not disclose or suggest the subject matter disclosed in Joao. For example, Joao is directed toward an apparatus and a method for processing and providing healthcare and healthcare-related information. See, e.g., Abstract and col. 1, ll. 15-22. The '332 patent, however, is directed toward an apparatus and a method for acquiring, accumulating, analyzing, and applying psychological and psychopathological data. See, e.g., Abstract and col. 1, ll. 9-26. In fact, there is not a single figure or paragraph in Joao that is also included in the '332 patent. Therefore, Joao is not entitled to an earlier filing date, and is therefore not prior art to the present invention.

In rejecting independent Claims 35, 56 and 92, the Examiner relies exclusively on Joao for its disclosure of several limitations. See, e.g., pages 7, 10 and 17-18. Because Joao is not effective as a prior art reference, these rejections should be withdrawn. Additionally, the rejections of Claims 36, 39, 42, 44-47, 49-53, 55, 57, 60-64, 66-77, 79, 81-85, 87, 93, 94 and 96-101, which depend from the aforementioned independent claims, should also be withdrawn.

Furthermore, the Examiner's obviousness arguments are also rebutted by the Declaration of Frith Maier, which was submitted on November 25, 2005 and provided evidence of commercial success of the invention. Applicants presently offer software services to medical and dental professionals under the names Ortho Sesame<sup>SM</sup> and Dental Sesame<sup>SM</sup> that are covered by the claims of the patent application (Maier Decl., ¶ 3). These services enable doctors and dentists to significantly improve their patient communications, resulting in reduced no-shows, staff administration time savings, and significant improvements in patient satisfaction. Since their introduction, the Ortho Sesame<sup>SM</sup> and Dental Sesame<sup>SM</sup> services have been a tremendous commercial success (Maier Decl., ¶ 8).

Both the Federal Circuit and district courts have repeatedly noted that commercial success of the commercial embodiment of an invention is uncontroverted evidence of non-obviousness and is entitled to fair weight. See, e.g., *Leviton Mfg. Co. v. Universal Sec. Instruments, Inc.*, 304 F. Supp. 2d 726, 752 (D. Md., 2004) (citing *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1391 (Fed. Cir. 1988)). The commercial success of the Ortho Sesame<sup>SM</sup> and Dental Sesame<sup>SM</sup> services are directly attributed to the claimed features of the invention. Customer surveys show overwhelmingly that patients most appreciate the ability to access their medical records, schedule their appointments, and monitor billing status and pay bills through the web browser interface (Maier Decl., ¶ 9). These aspects of the services track directly with corresponding limitations of the independent claims -- particularly the limitations that are distinct from the prior art references of record.

Moreover, the Federal circuit has repeatedly noted that commercial success can be established by customer testimony, and ample customer testimony has been provided here. See, e.g., *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 668 (Fed. Cir., 2000); *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1351 (Fed. Cir., 2000); *Pro-Mold v. Great Lakes Plastics*, 75 F.3d 1568 (Fed. Cir., 1996); *Tate Access Floors Inc. v. Interface Architectural Resources*, 185 F. Supp. 2d 588, 604 (D. Md. 2002). For example, in *Winner Int'l Royalty Corp. v. Wang*, the Federal Circuit affirmed a finding of commercial success based on significant sales in the relevant market and a survey of customers indicating that the patented improvement was the reason they purchased the product. *Winner Int'l Royalty Corp.*, 202 F.3d at 1351. Furthermore, in *Pro-Mold v. Great Lakes*, the Federal Circuit noted that Pro-Mold's lack of previous experience in the relevant market combined with its high sales of the patented product provided an inference of a nexus between its commercial success and the patented invention and are thus probative evidence of non-obviousness. *Pro-Mold*, 75 F.3d at 1574. Finally, in *Tate Access Floors, Inc. v. Interface Architectural Res., Inc.*, a district court noted that affidavits from customers insisting on the particular product and noting that dealers were overjoyed by the product provided evidence of a nexus between the claimed invention and the commercial success of the commercial product. *Tate Access Floors, Inc.*, 185 F. Supp. 2d 588, 604 (D. Md. 2002).

Therefore, customer feedback regarding the Ortho Sesame<sup>SM</sup> and Dental Sesame<sup>SM</sup> services further supports attributing this commercial success to the claimed features of the product. For example, Dr. Curtis Sapp of Olympia, Washington stated "I think that patients observing their treatment online is a revolutionary idea. Sesame involves them in their treatment in a whole new way." Maier Decl., ¶ 9. Similarly, Dr. Barbara Hershey of Durham, North Carolina stated: "In a month, we saved over 350 phone calls to the front desk, because our patients were able to check their appointment times and financial status on our web site." Maier Decl., ¶ 9. Other like comments are presented in the Maier declaration, and may also be found on the Applicant's website.

This customer testimony supports the proposition that the commercial success of the services provided in accordance with this patent application, i.e., the Ortho Sesame<sup>SM</sup> and Dental Sesame<sup>SM</sup> services, was a direct result of the features claimed in this application. The evidence should therefore be accorded substantial weight. M.P.E.P. § 2144.08 II B. Thus, the long felt, but previously unmet need in the medical industry along with the commercial success, and broad acceptance by the industry of a service provided in accordance with the invention described in this patent application compel the conclusion that the Applicants' invention is not obvious.

As further evidence of the non-obviousness of the invention, Applicant's Ortho Sesame<sup>SM</sup> and Dental Sesame<sup>SM</sup> services have been slavishly copied by TeleVox, a Mobile, Alabama company. See Maier Decl., ¶ 11. TeleVox released T.Link in 2003 -- roughly three and a half years after Applicant released its software service. The Federal Circuit has recognized copying by others as objective evidence of non-obviousness. *Allen Archery, Inc. v. Browning Mfg. Co.*, 819 F.2d 1087, 1092 (Fed. Cir. 1987) (considering copying, praise, unexpected results, and industry acceptance as indicators of non-obviousness); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 679 (Fed. Cir. 1988) (considering copying as an indicator of non-obviousness).

The Examiner stated that the Maier Declaration, while moot in view of the new grounds of rejection, "would have been deemed to be insufficient and unpersuasive to overcome the rejections of the prior art and current Office Action." Office Action, page 35. The Examiner then suggested that the Maier Declaration is not entitled to much weight because "the affiant [Mr. Maier] is not independent of the inventor or the assignee." *Id.* The Applicants respectfully disagree. The Maier Declaration includes over a dozen statements from individuals who are independent of the inventor and the assignee. See Maier Decl., ¶ 9. These third-party statements are uncontroverted evidence of the present inventions' commercial success.

The Examiner further found that the evidence of copying was also unpersuasive, stating that "the alleged copying is not persuasive of nonobviousness when the copy is

not identical to the claimed product, and the other manufacturer had not expended great effort to develop its own solution.” Office Action, page 38. The evidence shows, however, that the TeleVox product (i.e., T.Link) is identical to the present invention and that TeleVox did not expend great efforts to develop its own solution. See Maier Decl., ¶ 11 (“Their product T.Link is a copy of our service feature-by-feature, report-by-report, and method-by-method. Many of T.Link’s interface screens are almost exact copies of our Sesame screens, with only minor semantic changes.”) Therefore, Applicants respectfully request reconsideration of the Maier Declaration as evidence of nonobviousness.

Lastly, the Examiner cites to Joao as support for the Examiner’s official notice that “it was well known in the electronic medical arts to send customized messages to patients based on their conditions or personal data.” Office Action, page 35. Joao, however, cannot provide such support since Joao is not effective as a prior art reference. Should the Examiner persist with this view in any subsequent action on the merits, Applicants respectfully request that the Examiner support this assertion of fact with evidence that may be considered by Applicants.

In view of the foregoing, Applicants respectfully submit that Claims 35-36, 39, 42, 44-47, 49-53, 55-57, 60-64, 66-77, 79, 81-85, 87, 92-94 and 96-101 are in condition for allowance. Reconsideration and withdrawal of the rejections is respectfully requested, and a timely Notice of Allowability is solicited. To the extent it would be helpful to placing this application in condition for allowance, Applicants encourage the Examiner to contact the undersigned counsel and conduct a telephonic interview.

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To the extent necessary, Applicants petition the Commissioner for a three-month extension of time, extending to November 16, 2006, the period for response to the Office Action dated May 16, 2006. Our check in the amount of \$510.00 is enclosed for the three-month extension of time pursuant to 37 CFR §1.17(a)(3). The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0639.

Respectfully submitted,



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